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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/507,471

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Valoris L Forsyth

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10/30/2008

DAY PITNEY LLP

ACCOUNT: ILLINOIS TOOL WORKS INC.

7 TIMES SQUARE

NEW YORK, NY 10036-7311

EXAMINER

CHEUNG, CHUN HOI

ART UNIT

PAPER NUMBER

4159

MAIL DATE

DELIVERY MODE

10/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/507,471	Applicant(s) FORSYTH ET AL.	
	Examiner CHUN CHEUNG	Art Unit 4159	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 3-10 and 13-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/06/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12/06/2004 is being considered by the examiner.

Specification

2. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being over Claims 1 and 2 of U.S. Patent No.

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7,044,294. For double patenting to exist as between the rejected claims and patent claims 1 and 2, it must be determined that the rejected claims are not patentably distinct from claims 1 and 11. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and patent claims and, if so, whether those differences render the claims patentably distinct.

5. Claims 1 and 2 of patent recites “ the base including at least one cylindrical wall extending therefrom, said...slots through which latch elements pivot radially”(Patent Claim 1), “ a lid includes means for capturing said latch elements...said lid are detent engaged together" (Patent Claim 2).

6. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent application and covered by patented claims. It is clear that all the elements of claims 1 and 11 are to be found in claims 1 and 2 of the parent. The difference between claims of the application and claims of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claims 1 and 2 of the patent is in effect a “species” of the “generic” invention of claims. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1 and 11 are anticipated by claims 1 and 2 of the patent, it is not patentably distinct from Patent claims 1 and 2.

7. Claims 2 and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. U.S.

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Patent No. 7,044,294 in view of Lewis et al U.S. Patent No 6,193,068(hereinafter Lewis `068).

8. In Re Claim 2 and 12, Forsyth `294 does not disclose at least one cylindrical wall extends perpendicularly from said base in claim invention. However, Lewis `068 discloses a wafer container (10) with at least one cylindrical wall (14) extends perpendicularly from said base (Page 8, Column 3, Line 64-67).

Allowable Subject Matter

9. Claims 3-10, 13-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. U.S. Patent No. 5,366,079 discloses a retainer container for integrated circuit wafer with a base, a plurality of a spaced upright arcuate members support on the base. U.S. Patent No. 5,553,711 discloses circuit wafer protective container with a base, a plurality of a spaced upright arcuate members support on the base and lid portion. U.S. Patent No. 5,611,448 discloses a wafer container with wafer protecting and securing member. U.S. Patent No. 5,724,748 discloses a packaging container with sealing mean on four sides for sealing the enclosure interior in stop position. U.S. Patent No. 5,725,100 discloses semiconductor wafer case with wafer holding material. U.S. Patent No. 6,193,090 discloses a reusable wafer container with male and female aligning

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member on four side of the container. U.S. Patent No. 6,286,684 discloses a protective circuit container with top and bottom cushion and latches push outward to close the lid portion. U.S. Patent No. 6,341,695 discloses a containment device with double cylindrical wall and hooks at the distal end for engagement with the lid. U.S. Patent No. 6,550,619 discloses a retainer container for integrated circuit wafer with a base, a plurality of a spaced upright arcuate members support on the base. U.S. Patent No. 6,564,946 discloses a containment device with double cylindrical wall and hooks at the distal end for engagement with the lid. U.S. Patent No. 6,915,906 discloses circuit wafer protective container with a base, a plurality of a spaced upright arcuate members support on the base and lid portion. U.S. Patent No. 7,225,929 discloses semiconductor wafer case with wafer holding material.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUN CHEUNG whose telephone number is (571)270-5702. The examiner can normally be reached on Monday to Friday: 7:30AM~5:00AM. Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571)272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

C.C.

/George Nguyen/
Supervisory Patent Examiner, Art Unit 4159